

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIBALD BURGER,
OUTI NEUBIG,
KIMMO LAPPALAINEN,
and
HANNU WAHLBERG

Appeal No. 2000-1078
Application No. 08/836,009

ON BRIEF

Before GARRIS, TIMM, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

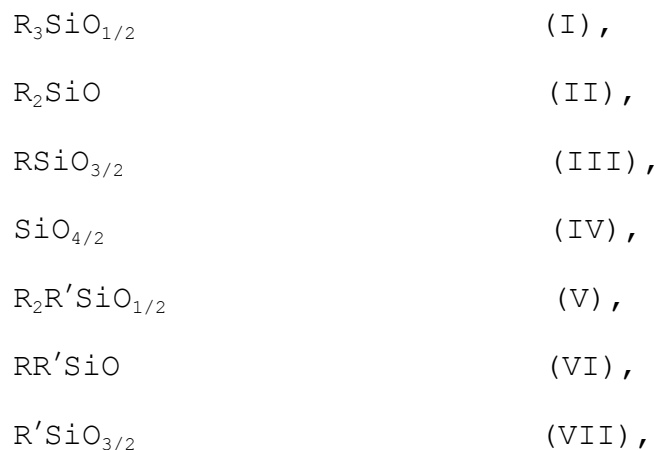
DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-5.
These are all of the claims in the application.

The subject matter on appeal relates to a process for
producing pulp wherein fibrous materials are reacted with a
chemical digesting solution in the presence of certain types of

organosilicon compounds. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

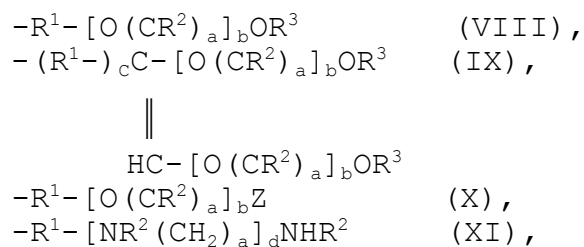
1. A process for producing pulp from fibrous materials, wherein the fibrous materials are reacted with a chemical digesting solution in the presence of organosilicon compounds which are selected from organo-polysiloxane compounds comprising units of the general formulae (I) to (VII)



where

R is a monovalent hydrocarbon radical having from 1 to 18 carbon atoms,

R' is a monovalent radical of the general formulae (VIII), (IX), (X) or (XI)



in which

- R^1 is a divalent C_1 - to C_{18} - hydrocarbon radical
- R^2 is a hydrogen atom or a monovalent C_1 - to C_6 -alkyl radical,
- R^3 is a hydrogen atom, a monovalent C_1 - to C_6 -acyl radical, C_1 - to C_6 -hydrocarbon radical, or OSO_3X ,
- X is a hydrogen atom, alkali metal ion or ammonium ion which is optionally substituted by C_1 - to C_{18} -hydrocarbon radicals,
- Z is a glycosidyl radical composed of from 1 to 10 mono saccharide units,
- a has a value 1, 2, 3, 4 or 5,
- b has a value from 0 to 200,
- c has a value 0 or 1 and
- d has a value 0, 1, 2, 3 or 4,

with the proviso that the organopolysiloxane compounds have at least one unit of the general formulae (V) to (VII), or from organosilanes of the general formula (XII)



in which

- R' is a monovalent radical of general formula (VIII) and
- R is a monovalent hydrocarbon radical having from 1 to 18 carbon atoms.

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The references relied upon by the examiner in his Section 102 and Section 103 rejections are:

Simmons et al. (Simmons)	3,147,179	Sep. 1, 1964
St. Joe Paper Co.	951,325	Mar. 4, 1964
(published Great Britain Patent Application) (hereinafter referred to as the British reference).		

Claims 4 and 5 are rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention. The examiner states that "equation (XII) [of claim 4] is described in terms of R when there is an R³ but not an R" and that "claim 4 uses R' both as 'polyoxyalkylene species' in equations (I)-(VII) and as 'a monovalent radical of general formula (VIII)' in equation (XII)' [and] [u]sing the same symbol R' to represent 2 different species in the same claim is confusing" (answer, page 4).

Claims 1-5 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Simmons or the British reference. According to the examiner, either of Simmons or the British reference "teaches producing pulp by reacting fibrous materials (wood) with a digesting chemical in the presence of organo-polysiloxanes including several polysiloxane species disclosed by Applicant,"

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and "[a]ny difference between the claimed species and those of [Simmons or the British reference] would have been obvious modifications of the species of [Simmons or the British reference]" (answer, page 3).

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

We cannot sustain any of the rejections before us on this appeal.

Having fully considered the examiner's aforequoted criticisms of claim 4 terminology, we are led to the determination that the claim terminology in question does not offend the second paragraph of Section 112. Our reasons for this determination correspond to those expressed by the appellants on pages 2 and 3 of the reply brief. It follows that the Section 112, second paragraph, rejection of claims 4 and 5 will not be sustained.

As for the Section 102 rejection, we share the appellants' view that none of the prior art compounds specifically identified in the examiner's answer satisfies the compound-requirements

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defined by the appealed claims. In particular, these claims require compounds which have at least one R' radical and thus, at least one -Si-C-O- linkage or unit and which do not have a -Si-O-C- linkage or unit. On the other hand, the Simmons or British reference compounds specifically identified in the answer possess at least one -Si-O-C- linkage or unit but do not have a -Si-C-O- linkage or unit. Moreover, we have found no prior art compounds which satisfy the compound-requirements of the appealed claims in our own independent study of Simmons and the British reference. Under these circumstances, the Section 102 rejection of claims 1-5 as being anticipated by Simmons or the British reference also cannot be sustained.

Concerning the Section 103 rejection, the examiner has advanced no reasoned exposition of how and why an artisan with ordinary skill would have modified the compounds of Simmons or the British reference in such a manner as to result in compounds of the type defined by the appealed claims. It follows that the examiner has failed to carry his initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Again, our independent study of Simmons and the British reference reveals inadequate support for a prima facie case of obviousness.

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Therefore, the Section 103 rejection of claims 1-5 as being unpatentable over Simmons or the British reference likewise cannot be sustained.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CATHERINE TIMM)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
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)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

BRG:hh

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